

6/28/02

**THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB**

Paper No. 18  
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re DLI Engineering Corporation

Serial No. 75/725,583

Donald L. Otto of Renner, Otto, Boisselle & Sklar, LLP for DLI Engineering Corporation.

Rebecca Gilbert, Trademark Examining Attorney, Law Office 113 (Meryl Hershkowitz, Managing Attorney).

Before Hohein, Walters and Bottorff, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

DLI Engineering Corporation, d.b.a. PREDICT/DLI, has filed an application to register the mark "SMARTMACHINE



SmartMachine Technologies  
www.smartmachinery.com

TECHNOLOGIES WWW.SMARTMACHINERY.COM" and design, as shown below, for "computer software and hardware for predicting and communicating maintenance needs for industrial machinery."<sup>1</sup>

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "SMART MACHINES," which is registered for "computer programs and programs [sic] manuals all sold as a unit,"<sup>2</sup> as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as

---

<sup>1</sup> Ser. No. 75/725,583, filed on July 8, 1999, which is based on an allegation of a bona fide intention to use the mark in commerce. Inasmuch as the merely descriptive phrase "SMARTMACHINE TECHNOLOGIES" appears in applicant's mark in the format "SmartMachine Technologies," the application contains a disclaimer of the terms "SMART MACHINE TECHNOLOGIES" as well as a disclaimer of the World Wide Web address "WWW.SMARTMACHINERY.COM".

<sup>2</sup> Reg. No. 1,468,041, issued on the Principal Register on December 8, 1987, which sets forth dates of first use anywhere and in commerce of August 15, 1984; combined affidavit §§8 and 15. The word "SMART" is disclaimed.

indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and/or services and the similarity of the marks.<sup>3</sup> Here, inasmuch as applicant's goods, as discussed below, are identical in part and otherwise closely related to registrant's goods, the primary focus of our inquiry is on the similarities and dissimilarities in the respective marks when considered in their entireties. Moreover, as pointed out in *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994), "[w]hen marks would appear on virtually identical goods ... , the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines."

Turning, as a preliminary matter, to consideration of the respective goods, applicant asserts that its "computer software and hardware ... are integrated to predict and communicate maintenance needs for industrial machinery [and] are clearly not encompassed by the computer programs of the cited registration." It is well settled, however, that that the issue of likelihood of confusion must be determined on the basis of

---

<sup>3</sup> The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and differences in the marks."

the goods as they are set forth in the involved application and cited registration. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, and as pointed out by the Examining Attorney, "where a registrant's goods are broadly identified as computer programs ..., without any limitation as to the kind of programs or the field of use, it is necessary to assume that the registrant's goods encompass all such computer programs, and that they would travel in the same channels of trade normal for those goods and [would be sold] to all classes of prospective purchasers for those goods." See, e.g., In re Linkvest S.A., 24 USPQ2d 1716 (TTAB 1992); and In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

Here, it is plain that the "computer programs and programs [sic] manuals" set forth in registrant's registration encompass the "computer software ... for predicting and communicating maintenance needs for industrial machinery" listed in applicant's application and that registrant's goods, in view thereof, are also closely related to the "computer ... hardware for predicting and communicating maintenance needs for industrial machinery" identified in such application. Accordingly, because in legal contemplation registrant's goods

are identical in part and otherwise closely related to applicant's goods, the contemporaneous use of the same or substantially similar marks in connection therewith would be likely to cause confusion.

Turning, therefore, to consideration of the marks at issue, applicant "submits [that] there is no basis whatsoever for the Examining Attorney's contention that the dominant feature of appellant's mark is 'SMARTMACHINE'" inasmuch as such "is inconsistent with" the disclaimer requirement which the Examining Attorney imposed and with which applicant complied. Applicant asserts, on the other hand, that the term "MACHINES" in registrant's mark "is clearly the dominant feature ... as evidenced by the fact that the wording 'SMART' was disclaimed as being merely descriptive of computer programs and the mark was still permitted to be registered on the Principal Register without a showing of acquired distinctiveness." In view thereof, applicant argues that "both the registered mark and the appellant's mark are weak and entitled to a narrow scope of protection." Confusion is not likely, applicant additionally maintains, because:

[A] determination as to whether there is a likelihood of confusion requires that the marks be considered in their entirety, and it is respectfully submitted that the overall commercial impression created by appellant's mark SMARTMACHINE TECHNOLOGIES WWW.SMARTMACHINERY.COM is clearly different

from that of the registered mark SMART MACHINES.

We agree with the Examining Attorney, however, that there is a likelihood of confusion because the respective marks "share a highly similar commercial impression." As the Examining Attorney points out, "[t]he marks, SMARTMACHINE TECHNOLOGIES with website address and design and SMART MACHINES, share the common term 'SMART MACHINES', in singular or plural form," with the only other difference being that applicant's mark depicts the words comprising such term without any space between them. However, such differences are inconsequential when the marks, as they must be, are considered in their entirety. Customers for the respective goods will readily recognize the term "SMARTMACHINE" in applicant's mark as being the combined words "SMART MACHINE," especially since such term appears in the format "SmartMachine," and there is no substantive difference in the singular versus the plural form of such term. See, e.g., Wilson v. Delaunay, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) [there is no material difference, in a trademark sense, between the singular and the plural form of a word].

Moreover, the additional term "TECHNOLOGIES" in applicant's mark does not serve to distinguish that mark from registrant's mark. Specifically, whether such term, in view of

the disclaimer thereof, is viewed as "highly descriptive" of applicant's goods, as contended by the Examining Attorney, or is regarded as highly suggestive of the goods, in light of the statement in *In re Hutchinson Technology Inc.*, 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988), that "the fact that the term 'technology' is used in connection with computer products does not mean that the term is descriptive of them," the term "TECHNOLOGIES" is of little source-identifying significance in applicant's mark. Customers for applicant's and registrant's goods are not likely to look to the word "TECHNOLOGIES" as distinguishing applicant's mark from registrant's mark; instead, they are more likely to regard the term "SMARTMACHINE TECHNOLOGIES" as a variation of registrant's "SMART MACHINES" mark.

Furthermore, while applicant's mark also contains the website address "WWW.SMARTMACHINERY.COM" as well as a design feature which appears to be a stylized communications antenna, such elements are insufficient to differentiate applicant's mark from registrant's mark when the respective marks are considered in their entireties. The website address is clearly subordinate matter inasmuch as it appears below the phrase "SMARTMACHINE TECHNOLOGIES" in all lower case lettering which is substantially smaller than that in which the term "SmartMachine Technologies" is depicted. As to the design feature, while it is

significantly more prominently displayed, it is also highly suggestive of the communications capability of applicant's goods. Moreover, as correctly noted by the Examining Attorney:

[W]hen a mark consists of a word portion and a design portion, the word portion is [generally] more likely to be impressed upon a purchaser's memory and to be used in calling for the goods .... *In re Appetito Provisions Co. [Inc.]*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Americo, Inc.*, 192 729 (TTAB 1976). For this reason, the addition of the design element to the cited registered mark is insufficient to obviate the likelihood of confusion. The word portions of the marks, both containing a form of the term "SMART MACHINE", create a highly similar commercial impression.

Finally, we are not persuaded by applicant's remaining argument that term "MACHINES" in registrant's "SMART MACHINES" mark "is clearly the dominant feature ... as evidenced by the fact that the wording 'SMART' was disclaimed as being merely descriptive of computer programs." We recognize that the sole term in applicant's mark which is essentially shared by registrant's mark is the term "SMARTMACHINE," which applicant has disclaimed, along with the word "TECHNOLOGIES" and the website address "WWW.SMARTMACHINERY.COM," as being merely descriptive of its goods just as registrant, with respect to its mark and goods, has disclaimed the word "SMART." Although descriptive terms are, in general, given less weight when marks are compared in their entireties, we decline to find, as urged



by applicant, that the word "MACHINES" is the dominant and source-distinguishing portion of registrant's "SMART MACHINES" mark for its computer programs, yet when used by applicant in connection with legally identical goods, is of relatively little source-indicative significance, in light of applicant's disclaimer, when forming part of the legally equivalent term "SMARTMACHINE" in applicant's mark. Stated otherwise, when the marks at issue are used in connection with computer programs, it is simply illogical to argue that the word "MACHINE" is weak in reference to applicant's mark but that the word "MACHINES" is dominant in relation to the registered mark.

Consequently, notwithstanding the disclaimer of all the wording in applicant's mark and the disclaimer of the word "SMART" in registrant's mark, the respective terms remain part of the marks at issue and must be considered in determining whether the contemporaneous use thereof is likely to cause confusion as to source or sponsorship. As the Examining Attorney, citing *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) [technicality of disclaimer has no legal effect on the issue of likelihood of confusion because the public is unaware of what words have been disclaimed]; *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1285 (Fed. Cir. 1984) [confusion held likely due, inter alia, to fact that marks "SPICE VALLEY"

("SPICE" disclaimed) and "SPICE ISLANDS" for teas share "'SPICE (place)' format," which conveys a similar commercial impression]; and In re MCI Communications Corp., 21 USPQ2d 1534, 1538 (Comm'r Pats. 1991) [disclaimers have no legal effect for purposes of determining likelihood of confusion], properly observes: "A disclaimer does not remove the disclaimed portion from the mark."

We therefore concur with the Examining Attorney that, "[i]n the instant case, the public is clearly likely to view the marks SMARTMACHINE TECHNOLOGIES with web address and design and SMART MACHINES as highly similar" and that, irrespective of the disclaimers, the marks at issue project essentially the same overall commercial impression when utilized in connection with, respectively, applicant's computer software and hardware for predicting and communicating maintenance needs for industrial machinery and registrant's computer programs and manuals utilized for the same purpose. See, e.g., Industria Espanola De Perlas Imitacion, S.A. v. National Silver Co., 459 F.2d 1049, 173 USPQ 796, 798 (CCPA 1972) [because the issue of likelihood of confusion must be resolved upon a consideration of the marks in their entirety, "[d]isclaimed material forming part of a trademark cannot be ignored in determining whether the marks are confusingly similar"].

Accordingly, we conclude that customers and prospective purchasers, familiar with registrant's "SMART MACHINES" mark for computer programs and program manuals all sold as a unit, would be likely to believe, upon encountering applicant's substantially similar "SMARTMACHINE TECHNOLOGIES WWW.SMARTMACHINERY.COM" and design mark for computer software and hardware for predicting and communicating maintenance needs for industrial machinery, that such identical in part and otherwise closely related goods emanate from, or are otherwise sponsored by or affiliated with, the same source.

**Decision:** The refusal under Section 2(d) is affirmed.